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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/627,018	07/27/2000	Helmut Weber	70442.1201	9975

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EXAMINER

THALER, MICHAEL H

ART UNIT PAPER NUMBER

3731

DATE MAILED: 10/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/627,018

Applicant(s)

WEBER ET AL.

Examiner

Michael Thaler

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 18 July 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on July 18, 2005 has been entered.

Claims 1-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claims 1 and 8 "tip portion" is confusing and inaccurate. A tip portion, by definition is the extreme end of something. The horizontal shaft at the end of the lead line for reference numeral 202 in figure 2 is not a tip portion since it is not the extreme end of something. In claim 1, line 5, "and retract" is incorrect since the top shaft cutting piece does not retract when the front handle piece is compressed relative to the handle portion of the bottom shaft piece. In claim 1, line 13, there is no antecedent basis for "the body". In claim 2, line 3, there is no antecedent basis

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for "said top shaft". In claim 8, lines 4-5, the longitudinal axis extends does not extend from the handle portion to the tip portion. In claim 8, line 10, the bottom shaft piece remains linked to only the remainder the rongeur rather than the entire rongeur. The above problems may be cured by the following:

In claim 1,

lines 2 and 5, change "tip" to "shaft";

line 5, delete "and retract";

line 13, change "body" to "remainder".

In claim 2,

Line 3, insert "cutting piece" after "shaft".

In claim 5,

Line 4, change "tip" to "shaft".

In claim 8,

lines 4 and 7, change "tip" to "shaft";

lines 4-5, change "from said handle portion to said tip" to "along said shaft";

line 5, insert a comma after "portion";

line 7, delete the comma;

line 10, insert "the remainder of" after "to".

Claim 8 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C.

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103(a) as obvious over Wolf (G9421125.6). Wolf discloses a convertible rongeur comprising front handle piece 1.2, bottom shaft piece 2, 1.1 having shaft portion 2 and handle portion 1.1, top shaft cutting piece 5 slideably engaged along said longitudinal axis with the shaft portion 2, the top shaft cutting piece 5 being disengageable with the shaft portion 2 such that the top shaft cutting piece no longer touches the bottom shaft piece (when the top shaft cutting piece 5 is pivoted to the position shown in dashed lines in figure 1) but remains linked to the remainder of the rongeur (since it is still linked to movable jaw part 3.2 as indicated on page 5, lines 1-2 of the translation). Alternatively, it would have been obvious that the top shaft piece 5 is a "cutting" piece as claimed since it, in combination with the movable jaw part 3.2, performs the cutting action.

Claims 1-7 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

Applicant's arguments with respect to claim 8 have been considered but are moot in view of the new ground(s) of rejection.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Thaler whose telephone number is (571)272-4704. The examiner can normally be reached Monday to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anhtuan T. Nguyen can be reached on (571)272-4963. The fax phone number for the organization where this application or proceeding is assigned is (703)872-9306.

mht  
9/9/05



MICHAEL THALER  
PRIMARY EXAMINER  
ART UNIT 3731